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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,908	07/25/2003	Hiroiyuki Otaki	TJK/402	2412
27717	7590	05/04/2007		
SEYFARTH SHAW LLP 131 S. DEARBORN ST., SUITE2400 CHICAGO, IL 60603-5803				
			EXAMINER ANGEBRANNDT, MARTIN J	
			ART UNIT 1756	PAPER NUMBER
			MAIL DATE 05/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/626,908	Applicant(s) OTAKI ET AL.	
	Examiner Martin J. Angebrannndt	Art Unit 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/12/07 & 4/10/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 7-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The petition to revive the instant application was approved on 4/10/2007. The petition included an amendment to the claims and argument. The response of the applicant has been read and given careful consideration. Responses to the arguments are presented after the first rejection to which they are directed.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1,2,7,9,11 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no basis for the language describing the difference in breaking strength for the adhesive layer and the hologram layer as being 8% or less.

Example	adhesive	hologram layer
1	6.4%	6%
2	13.5%	6%
3	5.3%	6%
4	7.5%	6%
5	4.5%	6%
6	9.8%	6%
7	7.5%	6%
8	3.2%	6%

The data does not even support the applicant's position. Further, it is clear that there is no literal support for the language. The applicant must remove the unsupported language in the subsequent

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response. The applicant does have a basis for the difference being less than 7.5%, based upon example 2.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,2 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otaki et al. '521, in view of Killey '672.

Otaki et al. '521 teach a holographic transfer foil comprising a substrate, a holographic film having a breaking strain of 0.1-3% at 25 degrees C and 0.1-5% at 130 degrees C and an adhesive layer. The breaking strain of the holographic layer is preferably 0.1-1% at 25 degrees C and 0.1-1.5% at 130 degrees C [0035]. The use of a release/delaminating layer applied to the substrate is disclosed and this layer may be 0.1- 2 microns in thickness [0106-0107]. Useful materials for the heat sensitive adhesive layer are disclosed. [0102-103]. A barrier layer may be present between the release layer and the holographic layer to prevent migration of low molecular weight compounds from the release layer into the hologram layer [0111-1112]. Useful components for the holographic recording layer are disclosed and the holographic layer includes fine particles to impart a fragility to the holographic layer. [0038-0045, 0048-0092].

In the sample prepared for evaluation [0132+], a PET film was coated to 10 microns with the holographic composition, and had a breaking strain of 1.5 % at 25 degree C (table 1), the release layer was coated to a thickness of 1 microns on a support and the heat sensitive adhesive layer

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(EC1200) was coated to a thickness of 2 microns [0133-0142]. The types of particles include inorganic materials and various resin particles having sizes of 100-600 nm (0.1 to 0.6 microns) in amounts of 1-30% and serve to improve the foil cutting properties of the holographic layer. Materials for these including high density polyethylene, fluorinated resins, (meth)acrylic resins, polycarbonate, epoxy resins, urethane polymers and the like [0039-0045].

Killey '672 teaches that conventionally holographic transfer foils use hot seal adhesive compositions containing filler or pigments to aid in the disruption of the adhesive layer upon transfer to yield edges with clean breaks and well defined images. The use of ~10% of particles (1 part to 9 parts resin or 1 part in 10 parts total) is specifically disclosed. (8/56-9/23)

It would have been obvious to one skilled in the art to modify the cited example of Otaki et al. '521 by adding particles, such as the resin particles described at [0042-0044] to the adhesive layer in an amount of 10 parts for every part of the adhesive composition as taught by Killey '672 with a reasonable expectation of improving the image definition, further one of ordinary skill would have found it obvious to one skilled in the art to optimize the amount of particles to have both the adhesive layer and the holographic layer break at the same place to produce well defined images and to use such particles as disclosed as useful in imparting the same fragility in the hologram layer to perform the same function in the adhesive layer.

With respect to the argued limitation added to claim 1, this is new matter, but in view of the teachings of the desirability of improving the breaking/ foil cutting properties in Otaki et al. '521 and Killey '672 would have been obvious as it would clearly be a move away from these teachings to have the adhesive and holographic layers break in different places and so minimizing the differences in elongation and break strength between these two layers would be a

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matter of routine optimization. With respect to the arguments relating to the resin particles, the examiner notes that the high density polyethylene, fluorinated resins, (meth)acrylic resins, polycarbonate, epoxy resins, urethane polymers and the like listed by Otaki et al. '521 are also listed by the applicant at [0059-0060]. Further any of the organic resin materials will inherently fluoresce in the UV. The issue of functionalization of the surface and adding a colorant is not commensurate in scope with the coverage sought as these are unrecited features. Further inorganic materials can be surface functionalized (particularly silica) and colored with additives. The rejection stands.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

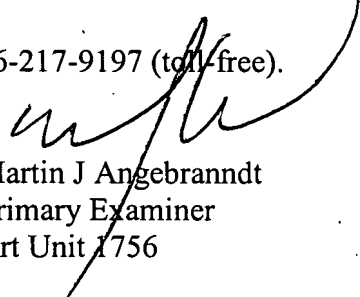
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J. Angebrannt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Martin J Angebrannt
Primary Examiner
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04/30/2007